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26161	7590	10/10/2008	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				CHUO, TONY SHENG HSIANG
ART UNIT		PAPER NUMBER		
1795				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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***Response to Arguments***

1. The applicant argues that the examiner has not identified some reason that would have led a chemist to modify Menashi to provide the subject matter covered by the claims. In response, according to MPEP 2144, Section III, “Legal precedent can provide the rationale supporting obviousness only if the facts in the case are sufficiently similar to those in the application” and “If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court”. After reviewing the facts of the *Ex parte Dole* case, the examiner maintains the contention that the facts in the case are sufficiently similar to those in the application. According to the facts in the case, the compound of the appealed claim contains one more chlorine atom (halogen) substituted on the methyl group on each side of the sulfonyl radical than the reference compound. In addition, the decision of the case stated that "while the composition claimed is not a homolog of the reference composition, its relation thereto is so similar to the relation which exists among homologs because it is quite obvious that, generally the chemical and physical properties of the chlorinated butyric acid would be expected to gradually vary as more hydrogen is replaced by chlorine". Further, the decision stated that "While it must be conceded that the claimed compound is neither a homolog nor an isomer of the reference compound, that fact alone does not, in our opinion, make improper the examiner's requirement that there be a showing made that the claimed compound has unexpected beneficial properties not shared by the reference compound." Since the applicant has not provided any factual evidence showing unexpected beneficial

properties not shared by the reference compound, the examiner maintains that the applicant's sulfonic acid moiety having the formula  $\text{RSO}_3\text{H}$ , wherein R is an alkenyl moiety substituted with halogen is not seen to patentably distinguish over the Menashi compound.

TC

/Jonathan Crepeau/  
Primary Examiner, Art Unit 1795